

RESPONSE UNDER 37 C.F.R. § 1.116

EXPEDITED PROCEDURE – Art Unit 3727

Attorney Docket No. 108298529US

Disclosure No. 99-1289.00/US

REMARKS

Claims 2, 4-8, 10-12, 14-17, 19-22, 24-26 and 73-83 are pending in the present application. In the Final Office Action mailed June 17, 2004, claims 2, 4-7, 10-12, 19, 21, 22, 26 and 73-83 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) Claims 2, 4-7, 10-12, 19, 21, 22, 26 and 73-83 were rejected under 35 U.S.C. § 112, first paragraph;
- (B) Claims 2, 4-7, 10-12, 19, 21, 22, 26 and 73-83 were rejected under 35 U.S.C. § 112, second paragraph;
- (C) Claims 4-6, 10-12, 19, 21, 26, 73-75 and 78-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,263,734 to Bradshaw in view of U.S. Patent No. 2,984,035 to Nalle Jr. ("Nalle");
- (D) Claims 2 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw and Nalle in view of U.S. Patent No. 3,338,458 to Hultgren ("Hultgren"); and
- (E) Claims 7 and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw and Nalle in view of U.S. Patent No. 3,912,100 to Graham et al. ("Graham").

A. Response to the Section 112, First Paragraph Rejection

Claims 2, 4-7, 10-12, 19, 21, 22, 26 and 73-83 were rejected under 35 U.S.C. § 112, first paragraph. Regarding claims 73 and 74, the Examiner alleges that "it has not been adequately disclosed that 'the background material being configured so that the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region'." Regarding claim 75, the Examiner alleges that "it has not been adequately disclosed that 'the background material being positioned in the first region at a first distance spaced apart from the base portion and being absent from the second

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region at a second distance spaced apart from the base portion, the second distance being at least approximately equal to the first distance'."

MPEP § 2163 states, "The first paragraph of 35 U.S.C. 112 requires that the 'specification shall contain a written description of the invention'. . . To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. . . . An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention."

Figures 2 and 3C and the corresponding text on page 7, lines 9-19 of the present application illustrate that the patent specification describes the claimed invention, including the above-noted features cited by the Examiner, in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. More specifically, the patent specification recites, "An advantage of this feature is that the practitioner can view the chemical substance 170 within the vessel 220 against both the lower part 258 and the upper part 259 of the background material 250. . . . Another feature of an embodiment of the vessel 220 described above with reference to Figure 2 is that the periphery 257 of the background material 250 has an elliptical shape. Accordingly, the background material 250 can cover part of the interface region 223 and/or the wall portion 222, while the remainder of the wall portion 222 is uncovered to give the practitioner a clear view of the chemical substance 170." (P. 7, ll. 11-13 and 15-19.) Because the specification shows that the applicant had possession of the claimed invention at the time the application was filed, the Section 112, first paragraph rejection of claims 73-75 and their respective dependent claims should be withdrawn.

Regarding claims 5 and 78, the Examiner alleges that "it has not been adequately disclosed that the background that is between the inner and outer surface of the wall portion or the base portion (see Fig. 3C of the instant invention) also includes a

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protective layer. See the specification of the instant invention on page 8, lines 25-26, where it is stated that there is no need for a protective coating." While the specification notes that an advantage of the particular embodiment illustrated in Figure 3C is that the background material does not need a protective coating, the specification does not state that the background material in this particular embodiment cannot have a protective coating. Moreover, in several embodiments described in the specification, the background material has a protective coating. There is no requirement that every embodiment of the invention be described in the application. Accordingly, the Section 112, first paragraph rejection of claims 5 and 78 should be withdrawn because the specification shows that the applicant had possession of the claimed invention at the time the application was filed.

B. Response to the Section 112, Second Paragraph Rejection

Claims 2, 4-7, 10-12, 19, 21, 22, 26 and 73-83 were rejected under 35 U.S.C. § 112, second paragraph. Section 112, second paragraph requires that "the scope of the claim [be] clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." (MPEP § 2171.) For the reasons described below, the scope of these claims would be clear to one of ordinary skill in the art.

Claims 73 and 74 include, *intra alia*, a "background material being configured so that the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region." Regarding this claim feature, the Examiner alleges that "It is not clear what structure is required to satisfy this limitation. It is not clear what is being claimed." The undersigned attorney is puzzled as to why it is not clear to the Examiner what structure is required to satisfy this limitation. One of ordinary skill in the art would understand that this claim feature defines the configuration and position of the background material.

Claim 75 includes, *intra alia*, a "background material being positioned in the first region at a first distance spaced apart from the base portion and being absent from the second region at a second distance spaced apart from the base portion, the second

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distance being at least proximately equal to the first distance." Regarding this claim feature, the Examiner alleges that "It is not clear what structure is required to satisfy this limitation. It is not clear what is being claimed." The undersigned attorney is puzzled as to why it is not clear to the Examiner what structure is required to satisfy this limitation. One of ordinary skill in the art would understand that this claim feature defines the configuration and position of the background material.

Claims 5 and 78 include, *inter alia*, "a protective layer adjacent to the second surface of the background material." Regarding this claim feature, the Examiner states, "It is not clear what structure is required to satisfy this limitation. It is not clear what is being claimed." The undersigned attorney is puzzled as to why it is not clear to the Examiner what structure is required to satisfy this limitation. One of ordinary skill in the art would understand that this claim feature recites a protective layer adjacent to the second surface of the background material. Because the scope of these claims would be clear to a person possessing the ordinary level of skill in the pertinent art, the Section 112, second paragraph rejection of these claims should be withdrawn.

C. Response to the Section 103(a) Rejection Over Bradshaw and Nalle

Claims 4-6, 10-12, 19, 21, 26, 73-75 and 78-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw in view of Nalle.

1. Claim 74 Is Directed to a Vessel Including a Background Material Configured so that the Entire Surface of the Background Material in a Base Portion and in a First Region of a Wall Portion Is Visible Through a Second Region of the Wall Portion from an Exterior Region

Claim 74 is directed to a vessel for observing a chemical substance. The vessel includes a base portion, an optically transmissive wall portion projecting away from the base portion, and a background material. The base portion has an inner surface and an outer surface. The optically transmissive wall portion has an inner surface, an outer surface, a first region, and a second region opposite the first region. The outer surfaces of the base and wall portions define an exterior region, and the inner surfaces of the base and wall portions define an interior region. The interior region is configured to

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contain the chemical substance and has an opening configured to removably receive the chemical substance. The background material has a first surface facing toward the interior region and a second surface facing away from the first surface. The background material is positioned between the inner and outer surfaces of the base portion and the wall portion. The background material is configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region. Accordingly, the background material allows a practitioner to view the chemical substance against the background material without having to separately support and move an adjacent piece of background material, such as a sheet of paper or a paper towel.

2. Bradshaw Discloses a Ceramic Cup with a Sheet in a Peripheral Wall

Bradshaw discloses a ceramic cup having a peripheral wall with a thickened wall portion. The thickened wall portion includes a recessed area with a flat bottom wall. A sheet or strip having a picture is placed within the recessed area and secured to the flat bottom wall with a suitable cement. A transparent lense or window of plastic material is positioned in the recessed area over the sheet.

3. Nalle Discloses an Ornamental Double-Walled Tumbler

Nalle discloses a tumbler having an outer shell, an inner shell, an ornamental sheet interposed between the side walls of the outer and inner shells, and a paper disk interposed between the base portions of the outer and inner shells. The tumbler also has a flared upper edge that curves radially outward as it projects away from the base. The ornamental sheet extends from the flared edge to the base all the way around the tumbler. The ornamental sheet and paper disk enhance the heat insulating properties of the tumbler “so that a cold drink stays cold longer, without moisture or dew dripping from its outer walls, while a hot drink stays hot longer, and can be held in the hand without discomfort.” (Nalle, col. 2, ll. 55-58.)

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4. The Office Action Fails to Establish a *Prima Facia* Case of Obviousness for Claim 74

The MPEP requires the Examiner to set forth a *prima facia* case of obviousness. If the Examiner does not produce a *prima facia* case, the applicant is under no obligation to submit evidence of non-obviousness. A *prima facia* case requires the Examiner to provide, *inter alia*, prior art references that disclose all the elements of the claim. (MPEP § 2143.) As discussed below, the combination of Bradshaw and Nalle fails to disclose all the features of claim 74.

The combination of Bradshaw and Nalle fails to disclose, *inter alia*, "an optically transmissive wall portion . . . having an inner surface, an outer surface, a first region, and a second region opposite the first region" and "a background material having a first surface facing toward the interior region and a second surface facing away from the first surface . . . the background material being configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region," as recited in claim 74. The only optically transmissive portion of Bradshaw's cup is the window 29. As such, the interior facing surface of Bradshaw's sheet is not visible through the window from an exterior region. To the contrary, only the exterior facing surface of the sheet is visible through the window from an exterior region. Moreover, even assuming for the sake of argument that, as the Examiner suggests, it would be obvious to place Nalle's paper disk in the bottom of Bradshaw's cup, the paper disk would not be visible through the window from an exterior region because (a) the bottom of Bradshaw's cup is not optically transmissive, (b) the portion of the peripheral wall between the sheet and the interior region of Bradshaw's cup is not optically transmissive, and (c) Bradshaw's sheet obstructs the view through the window of anything behind the sheet. Consequently, the combination of Bradshaw and Nalle fails to disclose each and every feature of claim 74. Therefore, the Section 103(a) rejection of claim 74 should be withdrawn.

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Claims 4-6 and 10-12 depend from claim 74. Accordingly, the Section 103(a) rejection of these claims should be withdrawn for the reasons discussed above with reference to claim 74 and for the additional features of these claims.

Independent claim 73 includes, *inter alia*, features generally similar to those included in claim 74. Accordingly, the Section 103(a) rejection of claim 73 should be withdrawn for the reasons discussed above with reference to claim 74 and for the additional features of claim 73.

Claims 19, 21 and 26 depend from claim 73. Accordingly, the Section 103(a) rejection of these claims should be withdrawn for the reasons discussed above with reference to claim 73 and for the additional features of these claims.

5. Claim 75 Is Directed to a Vessel Including a Background Material Positioned in a First Region of an Optically Transmissive Wall Portion and Absent from a Second Region of the Optically Transmissive Wall Portion

Claim 75 is directed to a vessel for observing a chemical substance. The vessel includes a base portion, an optically transmissive wall portion projecting away from the base portion, and a background material. The base portion has an outer surface and an inner surface. The optically transmissive wall portion has an inner surface, an outer surface, a first region, and a second region opposite the first region. The outer surfaces of the base and wall portions define an exterior region, and the inner surfaces of the base and wall portions define an interior region. The interior region is configured to contain the chemical substance and has an opening configured to removably receive the chemical substance. The background material has a first surface facing toward the interior region and a second surface facing away from the first surface. The background material is positioned between the inner and outer surfaces of the base portion and the wall portion. The background material is positioned in the first region of the wall portion at a first distance spaced apart from the base portion. The background material is absent from the second region of the wall portion at a second distance spaced apart from the base portion. The second distance is at least approximately equal to the first distance. Accordingly, the background material allows a practitioner to view the

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chemical substance against the background material without having to separately support and move an adjacent piece of background material, such as a sheet of paper or a paper towel.

6. The Office Action Fails to Establish a *Prima Facia* Case of Obviousness for Claim 75

The combination of Bradshaw and Nalle fails to disclose all the features of claim 75. For example, Bradshaw and Nalle fail to disclose "an optically transmissive wall portion . . . having an inner surface, an outer surface, a first region, and a second region opposite the first region" with a "background material being positioned between the inner and outer surfaces of [] the wall portion, the background material being positioned in the first region at a first distance spaced apart from the base portion and being absent from the second region at a second distance spaced apart from the base portion," as recited in claim 75. The only optically transmissive wall portion of Bradshaw's cup is the window, and the sheet is not positioned between inner and outer surfaces of the window. To the contrary, the sheet is positioned between the window and the peripheral wall. Moreover, the sheet is not positioned in a first region of the window and absent from a second region of the window. Consequently, the combination of Bradshaw and Nalle fails to disclose each and every feature of claim 75.

Claims 76-83 depend from claim 75. Accordingly, the Section 103(a) rejection of these claims should be withdrawn for the reasons discussed above with reference to claim 75 and for the additional features of these claims.

Regarding claims 6, 10, 11, 19, 21, 79, 81 and 82, the undersigned attorney traverses the Examiner's assertion that it is well known to employ a specified color or a single hue.

D. Response to the Section 103(a) Rejection of Claims 2 and 76

Claims 2 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw and Nalle in view of Hultgren. Claims 2 and 76 depend from claims 74 and 75, respectively. Accordingly, claims 2 and 76 are patentable over Bradshaw and

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Nalle for the reasons discussed above with reference to claims 74 and 75 and for the additional features of these dependent claims. Furthermore, Hultgren fails to cure the above-noted deficiencies of Bradshaw and Nalle as references supporting a *prima facia* case of obviousness under Section 103(a). Therefore, the Section 103(a) rejection of claims 2 and 76 should be withdrawn.

E. Response to the Section 103(a) Rejection of Claims 7 and 80

Claims 7 and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw and Nalle in view of Graham. Claims 7 and 80 depend from claims 74 and 75, respectively. Accordingly, claims 7 and 80 are patentable over Bradshaw and Nalle for the reasons discussed above with reference to claims 74 and 75 and for the additional features of these dependent claims. Furthermore, Graham fails to cure the above-noted deficiencies of Bradshaw and Nalle as references supporting a *prima facia* case of obviousness under Section 103(a). Therefore, the Section 103(a) rejection of claims 7 and 80 should be withdrawn.

F. Conclusion

In light of the foregoing remarks, all of the pending claims are in condition for allowance. Applicant, therefore, requests reconsideration of the application and an allowance of all pending claims. If the Examiner wishes to discuss the above noted distinctions between the claims and the cited references or any other distinctions, the

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Examiner is encouraged to contact David Dutcher by telephone. Additionally, if the Examiner notices any informalities in the claims, he is encouraged to contact David Dutcher to expediently correct any such informalities.

Respectfully submitted,

Perkins Coie LLP

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